

Applicant : Steven K. Coulthard
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REMARKS

Claims 1-17 are pending. Claims 1 and 11 are amended. The Examiner rejected claims 1-17 under 35 U.S.C. § 112, first paragraph and under 35 U.S.C. § 103(a). The applicant respectfully traverses the rejections and requests reconsideration in view of the amendments and remarks herein.

I. The § 112 Rejections

The Examiner rejected claims 1-17 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner asserts that the claims contain subject matter not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor had possession of the claimed invention, at the time the application was filed.

In particular, the Examiner objects to the applicant's amendment to claims 1 and 11 to include "a continuous wall extending between the open end and the closed end forming the hollow interior" and that the open end is "permanently open". The Examiner asserts that neither of these changes is adequately supported by the written disclosure and the drawings do not given sufficient support.

The applicant respectfully disagrees with the Examiner's assertion that the changes are not adequately supported in the written disclosure. With respect to the amendment to include that the open end is permanently open, the amendment is consistent with the language used throughout the specification as well as all figures. There is no suggestion in the specification nor the figures of capping the open end of the apparatus. For example, at para [0003], the container is described as having an open end and a closed end. At para [0018], the container is again described as having an open end and a closed end. Further, the apparatus is depicted in FIGS. 1A-3 as having an open end without any suggestion of a stopper, cap or the like; the open end is therefore permanently open.

In fact, the open end of the container provides an advantage to the design. When a cigarette is placed into the container, the lit end draws the available oxygen from the closed end in an effort to stay ignited. This causes the lit end to slightly expand, lodging the cigarette in the

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container and self-extinguishing the cigarette. To remove the cigarette, the user can tap the closed end against a hard surface to break the vacuum formed between the extinguished end of the cigarette and the container and jar free the cigarette (See Specification, paras. 0031-0032). There is no need to seal off the open end of the container, even temporarily. By having the open end permanently open, the apparatus is easier for the user to operate, less likely to break and easier and less expensive to manufacture.

With respect to the amendment to the claims to the "continuous wall extending between the open end and the closed end forming the hollow interior", the applicant respectfully submits there is adequate support within the specification. First, all of the figures depict the container having a continuous wall extending between the open end and the closed end. For example, FIG. 1B shows a cross-sectional view of the apparatus, including the open end (120, FIG. 1A) and the closed end (125, FIG. 1B) and a continuous wall therebetween. The container is described as having thin walls (see para 0019) and the walls form the interior hollow region. There is no suggestion in the specification of the wall extending between the open and closed end as being anything other than continuous. Accordingly, the applicant respectfully submits the amendment is consistent with and supported by the language and figures included in the specification.

II. The § 103 Rejections

Claims 1-10

Claim 1 recites an apparatus for extinguishing and containing a cigarette. The apparatus includes a container having an open end, a hollow interior having a constant interior diameter, a closed end, and a continuous wall extending between the open end and the closed end forming the hollow interior. The open end is permanently open and is configured to receive a cigarette, the interior is configured to contain a cigarette and the container is configured to extinguish a cigarette. The apparatus further includes a clip including a first portion grasping an exterior of the container and a first and a second resilient arm. Each arm extends from the first portion configured to grasp a cigarette lighter, the first arm bowed toward the second arm and the second arm bowed toward the first arm, where a distal end of the first arm and a distal end of the second arm are not connected to one another. The apparatus also includes a bottle opener integral with the exterior of the container.

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The Examiner asserts that Hicks discloses all of the limitation of claim 1, other than the bottle opener. With respect to the container having a permanently open end, the Examiner states that the Hicks apparatus has a permanently opened end, since one having ordinary skill in the art would have been motivated to adapt an open end embodiment that is free from a closure mechanism, i.e., cap or lid. The applicant respectfully disagrees. The stopper disclosed in Hicks performs a function that is not required with the apparatus recited in claim 1. That is, the stopper seals off and terminates the flow of oxygen into the housing to extinguish the cigarette (see Col. 4, lines 53-57). Further, there is no discussion in Hicks as to how the cigarette would stay within the container without the stopper. By contrast, the container recited in claim 1 is configured to self-extinguish the cigarette and contain the cigarette while remaining permanently open on the open end (for example, as described above, with respect to the dimensions of the interior region and the behavior of the lit end of the cigarette drawing in oxygen and expanding and thereby lodging within the interior and self-extinguish the cigarette). Hicks discloses an embodiment in FIG. 4 that does not appear to include a stopper, but there is also no disclosure as to whether that embodiment can be used to extinguish the cigarette, or whether it can only be used to contain a previously extinguished cigarette. Accordingly, the applicant respectfully submits that there is no motivation presented in Hicks to modify the embodiment including the stopper with a permanently open ended device.

Claim 1 further recites that the hollow interior has a constant diameter. Hicks teaches away from a container having a hollow interior with a constant interior diameter. Hicks specifically discloses that the sidewalls taper radially outwardly from adjacent to the bottom toward the upper end, with a taper of about 1 degree with respect to its axis over the majority of its extent. Accordingly, the interior diameter of the container disclosed in Hicks clearly is not constant: rather there is a taper of 1 degree. Accordingly, not only does Hicks not disclose a container as recited in claim 1, but teaches against a container having a constant interior diameter.

The second limitation of claim 1 requires "a clip including a first portion grasping an exterior of the container, and a first and a second resilient arm, each arm extending from the first portion configured to grasp a cigarette lighter, the first arm bowed toward the second arm and the second arm bowed toward the first arm, where a distal end of the first arm is not connected to a

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distal end of the second arm". Hicks does not disclose such a clip. Hicks does disclose that a wire having a central extent in a generally oval shape can be pivotally secured to an oval collar secured to a central extent of the housing for optionally holding a lighter (Col. 5, lines 13-18). However, this wire does not disclose the clip recited in claim 1. The clip recited clearly includes a first and a second resilient arm, the arms bowed toward one another and configured to grasp a cigarette lighter. Hicks does not disclose a clip that includes two such resilient arms, and therefore fails to satisfy the limitation.

The Examiner asserts that Hicks shows two arms 64 joined by extent 66. However, as the claim calls for two arms having distal ends that are not connected to one another, the applicant respectfully submits that arms 64 do not disclose the arms recited in claim 1.

Hicks fails to disclose a bottle opener integral with the exterior of the container, as required by the claim. However, the Examiner relies on a combination of Hicks and Walker to satisfy this limitation. Walker discloses a multi-purpose tool, which may include a bottle opener and a lighter.

Applicant respectfully submits the Examiner has failed to show a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings" [MPEP, §2143]. The Examiner has combined a first reference, Hicks, that discloses a cigarette handling system, with a second reference, Walker, that discloses a multi-use tool.

The applicant respectfully submits there is no motivation to combine Hicks and Walker, either explicitly or implicitly in the references. Walker's tool does not include a container to retain a cigarette. The applicant respectfully submits there is no motivation, either express or implicit in the references, to combine Walker's teaching of a tool including a lighter and a bottle opener with Hicks' teaching of a cigarette handling system. To the contrary, Walker discloses that the multi-purpose tool could "easily fit within the pocket of a waiter or other server" and that the device "will enable multiple tasks to be accomplished in a quick effective manner that is critical in the service industry" (Col. 4, lines 13-18). The tool described can include a blade, cork screw, pen, lighter, bottle opener and flashlight. By contrast, a container to hold a partially

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smoked cigarette seems hardly to fit within the purpose of the multi-use tool described in Walker. Walker's tool is intended for service staff to perform their various service tasks. Carrying around a partially smoked cigarette does not seem appropriate for such a tool. Further, there is no motivation to combine suggested in Hicks. Hicks merely describes a cigarette handling system that, in one embodiment, can include a wire to optionally hold a lighter. There is no suggestion in Hicks of including one or more tools as part of the device. Accordingly, the applicant respectfully submits there is no motivation to combine Hicks and Walker.

Second, to establish a case of *prima facie* obviousness, "there must be a reasonable expectation of success". There is no reasonable expectation of success when combining Hicks and Walker, as neither disclose "a container having an open end, a hollow interior having a constant interior diameter, a closed end, and a continuous wall extending between the open end and the closed end forming the hollow interior, wherein the open end is permanently open and is configured to receive a cigarette, the interior is configured to contain a cigarette and the container is configured to extinguish a cigarette", as required by the claim. Further, neither disclose the clip required by the second limitation of claim 1. Thus, even in combination, there is no reasonable expectation of successfully producing an apparatus as recited in claim 1.

Third, "the prior art reference (or references when combined) must teach or suggest all the claim limitations" [MPEP, §2143]. Neither Hicks nor Walker, alone or in combination, disclose the limitations of claim 1. Particularly, as mentioned above, neither disclose the container or the clip as required by claim 1. Thus, even in combination, not all limitations are taught.

The Examiner further asserts that Walker is exemplary of numerous patents that teach the benefits of having a bottle opener attached to a cigarette lighter and that any bottle open that is attached to a cigarette lighter would also, in the combination of Hicks and Walker, be "connected to the exterior of the container". The applicant has amended claim 1 to clarify that the bottle opener is integral with the exterior of the container. Walker does not disclose a bottle open integral with a container as recited in claim 1, i.e., a container for extinguishing and containing a cigarette.

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Accordingly, the applicant respectfully submits that as a *prima facie* case of obviousness has not been established, claim 1 is allowable over Hicks in view of Walker. Claims 2-10 depend from claim 1 and are therefore allowable for at least the same reasons.

Claim 4

Claim 4 depends from claim 1 and is therefore allowable for at least the same reasons as claim 1. However, claim 4 is also independently allowable for at least the following additional reason. Claim 4 recites the apparatus of claim 1, wherein the interior diameter of the container is such that a lit cigarette will lodge in the interior of the cylindrical container and self-extinguish. As described in the specification at paragraphs 0031 and 0032, the lit end of the cigarette, when placed in the container, draws the available oxygen from the closed end of the container in an effort to stay ignited. The lit end thereby slightly expands. The interior diameter of the container is configured such that this slight expansion is sufficient to lodge the cigarette in the interior of the container. Because the cigarette is lodged and the lit end is at the closed end, once the oxygen between the cigarette and the closed end expires, the cigarette self-extinguishes due to lack of oxygen. Thus, the configuration serves a two-fold purpose: the cigarette self-extinguishes and the cigarette is contained within the container without requiring the open end to be closed.

Hicks fails to disclose a container having an interior diameter configured as such. As described in Hicks, a cigarette can be extinguished by closing the stopper to terminate oxygen and therefore extinguish the cigarette. There is no discussion in Hicks as to whether the open ended embodiment (*e.g.*, FIG. 4), extinguishes a cigarette or is merely a cigarette holder. The Examiner asserts that Hicks teaches the limitation recited in claim 4 in Figure 1 and at column 2, lines 7-10. The applicant respectfully disagrees. At column 2, lines 7-10, Hicks merely describes a housing with an interior surface that is hollow for forming a chamber to receive a lit cigarette. However, there is no disclosure that the interior diameter is configured such that a lit cigarette will lodge in the interior and self-extinguish, as required by claim 4. Accordingly, claim 4 is allowable over Hicks.

Claims 11-17

Claim 11 recites an apparatus for extinguishing and containing a cigarette. The apparatus includes the following features:

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a container having:

an open end, a hollow interior having a constant interior diameter, a closed end, and a continuous wall extending between the open end and the closed end, wherein the open end is permanently open and configured to receive a cigarette, the interior is configured to contain a cigarette and the container is configured to extinguish a cigarette;

a first and a second resilient arm, each arm extending from the container configured to grasp a cigarette lighter, the first arm bowed toward the second arm and the second arm bowed toward the first arm, where a distal end of the first arm is not connected to a distal end of the second arm; and

a bottle opener integral with the exterior of the container.

For at least the reasons stated above in reference to claim 1, claim 11 is allowable over Hicks in view of Walker. Hicks in combination with Walker fails to disclose "a container having an open end, a hollow interior having a constant interior diameter, a closed end, and a continuous wall extending between the open end and the closed end, wherein the open end is permanently open and configured to receive a cigarette, the interior is configured to contain a cigarette and the container is configured to extinguish a cigarette", as required by the claim. Further, neither Hicks nor Walker disclose an apparatus includes a first and a second resilient arm extending from such a container configured to grasp a cigarette lighter, where a distal end of the first arm is not connected to a distal end of the second arm. Further, although Walker discloses a bottle opener, there is no motivation to combine the teachings of a multi-use tool disclosed in Walker with the cigarette handling system disclosed in Hicks. Accordingly, a *prima facie* case of obviousness has not been established and claim 11 is in condition for allowance. Claims 12-17 depend from claim 11 and are therefore allowable for at least the same reasons.

Claim 14

Claim 14 depends from claim 11 and is therefore allowable for at least the same reasons as claim 11. However, claim 14 is also independently allowable for at least the following additional reasons. Claim 14 recites the apparatus of claim 11, wherein the interior diameter of the container is such that a lit cigarette will lodge in the interior of the cylindrical container and

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self-extinguish. The discussion above with respect to claim 4 applies with respect to claim 14, That is, as described in the specification at paragraphs 0031 and 0032, the lit end of the cigarette, when placed in the container, draws the available oxygen from the closed end of the container in an effort to stay ignited. The lit end thereby slightly expands. The interior diameter of the container is configured such that this slight expansion is sufficient to lodge the cigarette in the interior of the container. Because the cigarette is lodged and the lit end is at the closed end, once the oxygen between the cigarette and the closed end expires, the cigarette self-extinguishes due to lack of oxygen. Thus, the configuration serves a two-fold purpose: the cigarette self-extinguishes and the cigarette is contained within the container without requiring the open end to be closed.

Hicks fails to disclose a container having an interior diameter configured as such. As described in Hicks, a cigarette can be extinguished by closing the stopper to terminate oxygen and therefore extinguish the cigarette. There is no discussion in Hicks as to whether the open ended embodiment (e.g., FIG. 4), extinguishes a cigarette or is merely a cigarette holder. Accordingly, claim 14 is allowable over Hicks.

No fees are believed due, however, please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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